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EXAMINER				
TSUL, WILSON W				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/777,046

**Applicant(s)**

LERNER ET AL.

**Examiner**

WILSON TSUI

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5-7-9, 10, 13, 15, 16, 19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5-7-9, 10, 13, 15, 16, 19, 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This non-final action is in response to the Appeal brief filed on: 07/09/08.
2. Claims 1, 3-4, 8, 11-12, 14, 17-18, and 20 are cancelled. Claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26 are pending. Claims 9, 13, 15, 21, and 23 are independent claims.
3. The basis of the previous rejection with respect to claim 7 (which explains the use of Price et al to solely teach the limitations of claim 7), is withdrawn, and a new basis of rejection using Schilit et al ('876), in combination with Price et al, is used to teach the limitations of claim 7.
4. Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, Schilit et al '876, and Wilcox et al in further view of Schilit et al '014.
5. Claims 5-7, and 21-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, and Schilit et al '876, in further view of Wilcox et al.
6. Claims 9, 10, 15, and 16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, and Schilit et al '876, in further view of Madduri.
7. Claims 13, and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, in view of Schilit et al '876.
8. Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, Schilit '876, and Wilcox et al, in further view of Madduri et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), Schilit et al (US Patent: 6,687,876, issued: Feb. 3, 2004, filed: Dec. 30, 1998), and Wilcox et al (US Patent: 5,592,568, issued: Jan. 7, 1997, filed: Feb. 13, 1995), in further view of Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997)

With regards to claim 2, which depends on claim 23, Price et al and Wilcox et al teaches *wherein said at least one of said clips*, as explained in the rejection for claim 23, and is rejected under the same rationale.

However, Price et al and Wilcox et al do not expressly teach wherein said clips *includes additional content*.

Schilit et al teaches *clips containing additional content*: whereas each clip comprises a context portion (Schilit et al, column 6, lines 45-50), and addition content information, such as attributes concerning the type (column 7, lines 23-26), identified content (column 7, lines 27-30), or time/date data (column 7, lines 35-39).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al, Schilit et al (Patent: 6,687, 876), and Wilcox et al's clips, such that they contain the additional information, as taught by Schilit et al. The combination would have allowed Price et al to have implemented "an annotation system for electronic documents ... with quick accessibility" (Schilit et al, column 3, lines 10-15)

10. Claims 5-7, and 21-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), and Schilit et al (US Patent: 6,687,876, issued: Feb. 3, 2004, filed: Dec. 30, 1998), in further view of Wilcox et al (US Patent: 5,592,568, issued: Jan.7, 1997, filed: Feb. 13, 1995).

With regards to claim 5, which depends on claim 23, Price et al teaches *wherein a storage storing said annotation and an image of the first content associated with the annotation* (column 5, lines 59-67, and column 6, lines 1-20: whereas, images, which include the first content associated with the annotation, and the ink annotation, is stored in a database).

With regards to claim 6, which depends on claim 23, Price et al teaches *a storage storing said annotations and a link to said content* (column 6, lines 1-20).

With regards to claim 7, which depends on claim 23, Price et al and Schilit et al teaches the *active content* (as similarly explained in the rejection for claim 23, and is rejected under similar rationale.) Additionally, Shilit et al further teaches the implementation of processing annotations with active content includes a *storage storing said annotations and an active of the first content associated with the annotation, and wherein the first content changes over time* (column 2, lines 55-62: whereas, stored annotations are adjusted accordingly when the active content/view changes over time).

With regards to claim 21, Price et al teaches a system comprising:  
*An input for receiving annotations associated with content*, as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

*A processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations and their associated content (Figure 4: whereas a clip includes two annotations and associated content), said processor executing instructions including:*

*Encompassing first content and an associated annotation in a first bounding box (Figure 4: whereas, first content and associated annotation is retrieved for a particular page (page 4 in the figure), such that a first bounding box is implemented).*

*Encompassing second content and an associated annotation in a second bounding box (Figure 4: whereas second content and associated annotation is retrieved for a particular page (page 7 in the figure), such that a second bounding box is implemented), wherein the first and second bounding boxes are non-contiguous (Figure 4: whereas, the first and second bounding boxes, bound content and annotations from different pages)*

*Outputting said renderable image (Figure 4: whereas a combination of clips are output for display in a renderable image/display-image-clip).*

*However, Price et al does not expressly teach and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed, and ... based on active content selection, combining the first bounding box, and the second bounding box to form one of said clips.*

*The combination of Price et al and Schilit et al teaches and the associated content will include a user interface to allow various selections of an active content change when*

*since the previous renderable image upon the user interface, the active content associated with the annotation has changed, and ... based on active content selection,* as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

However, the combination of Price et al and Schilit et al do not teach *combining* the first bounding box, *and* the second bounding box to form one of said clips.

Wilcox et al teaches *combining the first bounding box, and the second bounding box to form one of said clips* (Abstract: whereas, bounding boxes enclose image objects based on markings/word shape). Additionally, Wilcox et al teaches combining bounding boxes should the threshold between their neighbors are within a threshold distance from each other in a document (column 19, lines 49-54).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al's first and second bounding boxes, such that they can also have been combined to form a clip, as taught by Wilcox et al. The combination of Price et al, Schilit et al, and Wilcox et al would have allowed Price et al to have "recognized keywords /strings (combination of smaller entities) without having to detect or recognize individual characters making up the strings (thus ultimately processing less entities)" (Wilcox et al, column 1, lines 49-51).

With regards to claim 22, which depends on claim 21, Price et al, Schilit et al, and Wilcox et al similarly teach *prior to combining the processor executes instructions which determine that the first bounding box and the second bounding box are within a*

*threshold distance from each other in a document*, as similarly explained in the rejection for claim 21, and is rejected under similar rationale.

Additionally, Price et al also teaches *wherein third content without an associated annotation is located in a third region located between the first and second regions* (column 3, lines 65-67, Figures 6A, and 6B: whereas content includes removal of associated annotation(s), and also omitted regions in between a first and second region are shown in Figure 4.)

With regards to claim 23, for a system performing a method similar to the method performed by the system of claim 21, is rejected under similar rationale.

With regards to claim 24, for a system performing a method similar to the method performed by the system of claim 22, is rejected under similar rationale.

With regards to claim 25, which depends on claim 6, Price et al teaches *wherein said annotations are from different documents* (Figure 4: whereas, annotations are from different pages/documents (pages 4 and 7)).

11. Claims 9, 10, 15, and 16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), and Schilit et al (US Patent: 6,687,876, issued: Feb. 3, 2004, filed: Dec. 30, 1998), in further view of Madduri (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, field: Feb. 12, 1999).

With regards to claim 9, Price et al teaches a method comprising:  
*Receiving at least two sets of an annotation and related content, the at least two sets being from non-contiguous portions of a document or portions of different documents*



(column 5, lines 31-43: whereas, at least two sets of annotations (each set of anchored ink marks are retrieved, based on the type of annotation/ink-anchor selected, as shown in Figure 4: whereas, multiple sets of anchored ink marks and their related content are retrieved.)

*Combining said at least two sets to from a combination consisting of non-contiguous portions of a document or portions of different documents or both* (Figure 4: whereas, a combination of at least two sets of anchored ink marks, are combined and displayed on the screen (the at least two sets of anchored ink marks are non-contiguous since one set appears on page 4, and the other set appears on page 17).

However, Price et al does not expressly teach ... *and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed, filtering said combination of said at least two sets, and displaying the filtered combination of said at least two sets.*

Yet, the combination of Price et al and Schilit et al teaches ... *and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface*, as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

However, the combination of Price et al and Schilit et al do not teach *filtering said combination of said at least two sets, and displaying the filtered combination of said at least two sets.*

Madduri et al teaches *filtering said combination of said at least two sets, displaying the filtered combination of said at least two sets* (column 8, lines 31-35, and column 8, lines 37-44: whereas a user can view a combination of annotated sets (whereas the sets are combined into a pool of annotated sets due to selecting a plurality of markup files), and further filter the collective combination to block certain sets for viewing).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al's set combination, such that the combination can be filtered, as taught by Madduri et al. The combination of Price et al, Schilit et al, and Madduri et al would have allowed Price et al to have allowed users to "have selectively displayed markings generated from other people without altering the underlying text document" (Madduri et al, column 3, lines 16-20).

With regards to claim 10, which depends on claim 9, Madduri et al teaches *filtering said combination of said at least two sets*, as similarly explained in the rejection for claim 9, and is rejected under similar rationale. Madduri et al further teaches the *filtering*, further includes retrieving the combination data from a file (column 8, lines 1-7: whereas the video controller retrieves selected/filtered combination data from a file).

With regards to claim 15, for a computer readable medium, having a program stored thereon, that performs a method similar to the steps explained in claim 9, is rejected under similar rationale..

With regards to claim 16, for a computer readable medium, having a program stored thereon, that performs a method similar to claim 10, is rejected under similar rationale.

12. Claims 13, and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), in view of Schilit et al (US Patent: 6,687,876, issued: Feb. 3, 2004, filed: Dec. 30, 1998).

With regards to claim 13, Price et al teaches a method comprising:

*Receiving data regarding an annotation* (column 5, lines 3-25: whereas, sets of ink annotations are received)

*Storing a link to context information with said annotation data in a storage* (column 6, lines 3-20: whereas, links to context information are stored through link databases)

*Storing associations regarding at least two documents from which said annotation originates* (column 6, lines 1-20: whereas association data between annotations, and one or more pages are stored).

*Wherein selection of said annotation accesses the at least two documents to display said annotation* (column 5, lines 31-39: whereas, a particular annotation is selected, and multiple documents are accessed as shown in Figure 4 to display said annotation.)

However, Price et al does not expressly teach *the data will include a user interface to allow various selections of an active content change when since the previous access session the active content change when since the previous access session the active content has changed, and .... Display said annotation based on the active content selection.*

Schilit et al teaches *the data will include a user interface to allow various selections of an active content change when since the previous access session the active content change when since the previous access session the active content has changed*

(column 2, lines 56-65: whereas, the active view content changes from the previous session, for which a user makes on a user interface) *and .... Display said annotation based on the active content selection* (column 2, lines 56-65: whereas the annotation display is updated as the view changes).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al's annotation system, such that annotation data is with respect to active content change since previous access session, as taught by Schilit et al. The combination of Price et al, and Schilit et al would have allowed Price et al to have "maintained the indication of relationships between freeform digital ink annotations and objects in a view as the view of the annotated objects changes", and also to "experience marking on paper to dynamic media" (Schilit et al, column 3, lines 10-16).

With regards to claim 19, for a for a computer readable medium, having a program stored thereon, Price et al teaches:

*Receiving data regarding an annotation, storing a link to context information with said annotation data in a storage, storing associations regarding at least two documents from which said annotation originates, wherein selection of said annotation accesses the at least two documents to display said annotation*, as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

Additionally, Price et al teaches *the at least two sets being from non-contiguous portions of a document or portion of different documents* (column 5, lines 31-43: whereas, at least two sets of annotations (each set of anchored ink marks are retrieved, based on

the type of annotation/ink-anchor selected, as shown in Figure 4: whereas, multiple sets of anchored ink marks and their related content are retrieved.))

However, Price et al does not expressly teach *the data will include a user interface to allow various selections of an active content change when since the previous access session the active content change when since the previous access session the active content has changed, and ....* Display said annotation *based on the active content selection.*

The combination of Price et al and Schilit et al teach *the data will include a user interface to allow various selections of an active content change when since the previous access session the active content change when since the previous access session the active content has changed, and ...* Display said annotation *based on the active content selection*, as similarly explained in the rejection for claim 13, and is rejected under similar rationale.

13. Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), Schilit et al (US Patent: 6,687,876, issued: Feb. 3, 2004, filed: Dec. 30, 1998), and Wilcox et al (US Patent: 5,592,568, issued: Jan.7, 1997, filed: Feb. 13, 1995), in further view of Madduri et al (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, field: Feb. 12, 1999)

With regards to claim 26, Price et al, Schilit et al, and Wilcox et al teach *said documents* (as similarly explained in the rejection for claim 23, and is rejected under

similar rationale). However, Price et al, and Wilcox et al do not expressly teach said documents *are from different application programs*.

Madduri et al teaches *said documents are from different application programs* (column 5, lines 1-16: whereas documents are from different programs such as WordPerfect, and Microsoft Word).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Price et al, Schilit et al, and Wilcox et al's system, such that the system uses documents from different application programs, as taught by Madduri et al. The combination of Price et al, Wilcox et al, and Madduri et al would have allowed Price et al to have implemented a system with documents "having text in any text format known in the art" (Madduri et al, column 5, lines 6-8).

### ***Response to Arguments***

14. In view of the appeal brief filed on: 06/07/2007, PROSECUTION IS HEREBY REOPENED (with SPE approval). New grounds of rejection are set forth below.

To avoid abandonment of this application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFG 1.111 (if this Office action is non-final) or a reply under 37 CFG 1.113 (if this Office action is final); or

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132) or other evidence are permitted. See 37 CFG 1.193(b)(2).

15. The applicant's arguments, see page 11 of applicant arguments of appeal brief filed 07/09/08, with respect to claim 7 have been fully considered and are persuasive. The 35 USC 103 rejection (Price et al, Schilit et al, and Wilcox) , which explains the use of Price et al to teach the limitations of claim 7, is withdrawn, and instead, Schilit is used to teach the active content changing over time.

16. The applicant's arguments with respect to claims 2 and 23 (page 11 of applicant arguments of appeal brief) are however, not persuasive. First the applicant argues that "nowhere in either Schilit reference is there any mention of an active content element that remotely suggests the inventive aspect of at least that element found within Applicant's claimed invention. However, as explained in claim 23, and in the rejection of claim 7 above, Schilit ('876), is used to show active content changing over time (column 2, lines 55-62: whereas, stored annotations are adjusted accordingly when the active content/view changes over time). Thus, the active content element is taught. Secondly, the applicant argues that "nowhere is there found within either Schilit reference an active content element being further associated with an annotation, and offering a combination of two or more annotations and their associated content and the associated content being included in a user interface". However, the examiner points out that active content, such as items on a page, can be further associated with an annotation, such as shown in Fig 6: whereas active content on a dynamic web page is associated with a

plurality of annotations, the annotations associated /having relationships with other content in the page (such as using an arrow type annotation), shown in an interface to the user. Thus, the applicant's argument is not persuasive.

17. With respect to claims 7 and 22 (page 11 and 12 of applicant's arguments in appeal brief), the applicant argues that the allowable subject material with respect to active content is included in claims 13 and 19. However, although the Examiner has recited in the advisory action that there may be allowable subject matter in the specification regarding active content elements, the examiner did not specifically indicate that limitations recited in claims 13 and 19 as being the allowable subject matter; and thus, the Examiner maintains the rejections for claim 7 and 22. However, the Applicant is invited to request an interview with the Examiner in the interest of *expediting* the application concerning the applicant's method for using/annotating active content.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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October 1, 2008